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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,818	08/22/2001	Jean-Michel Bernardon	016800-451	7237

7590

01/31/2003

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EXAMINER

JIANG, SHAOJIA A.

ART UNIT	PAPER NUMBER
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1617

15

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,818

Applicant(s)

BERNARDON ET AL.

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on January 10, 2003 in Paper No. 14 wherein claims 18-21 are cancelled. Currently, claims 2-6 and 8-17 are pending in this application.

Applicant's request for reconsideration of the finality of the rejection of the last Office action September 10, 2002 is persuasive as to that the expression, "regime or regimen" recited in the instant claims are not drawn to a composition but a method of treating herein (will be discussed further below), therefore, **the finality of that action is withdrawn.**

Applicant's amendment canceling claims 8-21, filed on January 10, 2003 in Paper No. 14, to remove the insufficient antecedent basis for this limitation in the claim is acknowledged.

It is noted that claims 14-17 are dependent on claim 1 which has been cancelled in Applicant's amendment filed July 11, 2002 in Paper No. 9.

Applicant's remarks filed on January 10, 2003 in Paper No. 14 and discussion in the interview on November 19, 2002, with respect to the rejection of claims 2-6 made under 35 U.S.C. 112 second paragraph for the expression, "regime or regimen" recited in the instant claims of record stated in the previous Office Action dated September 10,

2002 have been fully considered and found persuasive to remove the rejection since the instant are not drawn to a composition but a method of treating herein.

Therefore, the rejection of claims 2-6 and 8-21 examined as composition claims, made under 35 U.S.C. 102(b) as being anticipated by Bernardon (5,763,487) for reasons of record stated in the previous Office Action dated September 10, 2002 is withdrawn.

Applicant's remarks filed on January 10, 2003 in Paper No. 14, with respect to the rejection of claims 2-6 made under 35 U.S.C. 112 second paragraph for the expression, "such period of time...the desired response" recited in the instant claims and the expression "PPAR" in claim 8 of record stated in the previous Office Action dated September 10, 2002 have been fully considered and found persuasive to remove the rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 and 8-13 are rejected under 35 U.S.C. 112, second paragraph, for indefinite expressions, for reasons of record stated in the Office Action dated September 10, 2002.

Applicant's remarks filed on January 10, 2003 in Paper No. 14 with respect to the rejection of claims 1-17 for the expression "such period of time...the desired response"

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in claims 1-2 have been fully considered but are not deemed persuasive. As discussed in the previous Office Action, the scope of the claims is indefinite as to what may be considered as the "desired response" and how long of "such period of time" is since the specification does not provide a standard for ascertaining the requisite degree.

Applicant's remarks filed on January 10, 2003 in Paper No. 14 with respect to the rejection of claims 9-12 for "compound (I) comprising at least one linear or branch alkyl radical..." in claim 9 have been fully considered but are not deemed persuasive. As discussed in the previous Office Action, it is unclear to one of ordinary skill in the art which substituent in the structural formula herein, i.e., R_1 , R_2 ...or R_8 have this linear or branch alkyl radical in claim 9 or other groups in 10-12. Therefore, the scope of claims is unclear as to the method encompassed thereby.

The following is a new rejection because the instant claims are now examined as a method of treatment herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernardon (5,763,487, of record).

Bernardon discloses that the active instant compounds including the particular elected compound (see col.3 lines 50-53) are useful in methods of treating dermatological, and skin and hair conditions/disorders broadly such as dermal or epidermal proliferations, a keratinization disorder, and skin aging photoinduced or chronological. See abstract, col.1-2, col.3 lines 50-53, Example 20 at col.16 and claims 12-25. Bernardon also discloses the employment of retinoids, particular vitamin D compounds, corticosteroid, particular α -hydroxy or α -keto acids, and ion channel blockers in the combination with the instant compounds in methods therein (see col.6 lines 67). Bernardon further discloses that the administered route is topical (see col.7-8).

One of ordinary skill in the art would clearly acknowledge that the disorders herein such as the barrier function of human skin, disorders of the secretion of epidermal lipids, photodermatoses or ulcers, and/or disorders of the metabolism of lipids read on the dermatological, and skin and hair conditions/disorders such as dermal or epidermal proliferations, a keratinization disorder, and skin aging photoinduced or chronological in Bernardon's method. Moreover, Bernardon's method inherently treats the barrier function of human skin, disorders of the secretion of epidermal lipids, photodermatoses or ulcers, and/or disorders of the metabolism of lipids, as claimed herein since Bernardon's method steps are same as the instant method steps. See *Ex parte Novitski*, 26 USPQ 2d 1389. Thus, Bernardon anticipates the claimed invention.

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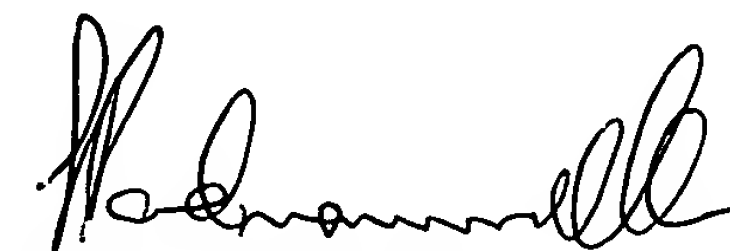
In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
January 29, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER

1/29/03